



RESPONSE UNDER 37 CFR 1.116
- EXPEDITED PROCEDURE -
ART UNIT 3402

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Mitja V. HINDERKS

Serial No.: 08/477,704

Group Art Unit: 3747

Filed: June 7, 1995

Examiner: N. Kamen

For: AN IMPROVED MEANS FOR TREATMENT OF THE GASES
OF COMBUSTION ENGINES AND THE TRANSMISSION OF
THEIR POWER

AMENDMENT

Honorable Commissioner of
Patents and Trademarks
Washington, DC 20231

Sir:

In response to the Final Rejection mailed April 13, 1999,
the period for response having been extended three months by the
attached Petition and fee, applicant submits the following
amendments and arguments.

IN THE CLAIMS:

Please cancel claims 78 to 217 and add the accompanying
claims 218-347.

REMARKS

Claims 218-347 have been specifically requested by applicant
to be submitted along with the Submission and the accompanying
letter from the applicant to the undersigned. This action does
not reflect the position of the undersigned in this matter.

Respectfully submitted,

Richard C. Harris
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October 4 1999

Reference: 08 / 477 704

Dear Richard:

Reviewing the file, it seems there has been some misunderstanding on my part, or perhaps the examiner's part, on what the various parties meant when they referred to "species", and perhaps on what the invention comprises..

When claims 59 to 77 were under examination, the examiner requested an election of species. As you know, claim 59 in combination with 60 related to a scotch yoke device, which in the embodiments showed the piston not to rotate while reciprocating. Other claims were directed to the piston rotating while reciprocating.

I responded by electing to direct the case to the concept of combined reciprocation and rotation. When you asked me to select a figure, I chose Figure 364, because it was a schematic diagram outlining the **base concept**. The relevant portion of text also disclosed schematically, with diagrams, how such combined motion can be transferred to a shaft only rotating. Also disclosed, with schematic illustration, was alternative ways of imparting combined motion, either by a guide or cam device (Figure 364) or by shaping the combustion chamber surfaces (Figure 369). Later in the disclosure, these concepts were described in greater detail and illustrated in various embodiments (Figures 392 through 407).

My understanding is as follows: The disclosure is the text, with the diagrams serving to assist in the understanding of the invention. A species is a group of inventions. Presumably it is not limited to a single invention (otherwise each patent would be a separate species). A wheel, defined as a rim separated from and revolving on an axis, seems to be a species, irrespective of how the separation of rim and axis is effected (this type of spoke or that type of strut).

When submitting claims 78 to 207 last year, I was absolutely convinced that main claims 78 to 82 belong to a single species, pistons that rotate as well as reciprocate. We discussed this fully at that time and also in March and April this year when the amendment was entered. I feel that the examiner is mistaken in seeking to create separate species here. As I mentioned, the only possible argument for any separation is to distinguish between the two basic ways combined motion is effected, and I would reluctantly agree to withdrawing claim 82 and dependent claims. (That relates to actuation by combustion chamber form.) In my view, the diagrams are a convenient hook or shorthand when seeking to distinguish species and are not really important in themselves - it is the disclosure in toto that counts.

continued

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to richard harris from mitja hinderks ref 08 / 477 704 10 4 99

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The description of the basic principles of the invention (to which claims in this case are directed) are outlined in the text from page 176 line 13 through page 182 line 8, Figures 364 through 376. Later, constructional and other features are described in page 186 line 12 through page 198 line 15, Figures 390 through 407.

The disclosure is very comprehensive, and several times it is clearly stated that any feature can be combined with any other feature and the diagrams are by way of example (eg page 104, lines 1 to 4; page 208, lines 1 and 2). It is probably not practical to illustrate all the different combinations of features in this long disclosure. Therefore, it seems fair to claim the reciprocating / rotating piston in combination with another feature, such a fluid passage in the piston, which is more or less how claims 78 to 81 were written.

The arguments by the examiner on separation into species are distinct from, and were made before the latest citation of prior art.

In the new claims I have drafted, the first three are main claims which I think read on a single species. One of the defining conditions is that the claims should not be mutually exclusive, and I feel these are not.

When we talked about this earlier, I said it was important that the examiner should have the fullest view of our understanding of the invention. Please be so kind as to include a copy of this letter with your next submission in the case. Hopefully the patent office will find it useful.

Best regards,

Mitja Hinderks.

